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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/902,588

07/12/2001

Yoshikado Sanemitsu

50006-111

9436

7590

09/30/2004

MCDERMOTT, WILL & EMERY  
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/902,588

Applicant(s)

SANEMITSU, YOSHIKADO

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/21/04 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/13/03, 7/12/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in  
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is  
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)  
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to  
37 CFR 1.114. Applicant's submission filed on July 21, 2004 has been entered.

### *Response*

10  
2. Receipt is acknowledged of the response filed on July 21, 2004. Currently, claims 1-4  
remain for examination.

### *Claim Rejections - 35 USC § 102*

15 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

20 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed  
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for  
patent by another filed in the United States before the invention by the applicant for patent, except that an  
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this  
subsection of an application filed in the United States only if the international application designated the United  
States and was published under Article 21(2) of such treaty in the English language.

25 4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US  
6,323,064, hereinafter "Lee").

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Lee discloses a mini card and the method for manufacturing the mini card (see abstract; col. 1, lines 11+; col. 1, lines 30+) wherein the substrate 60 form a plurality of unit substrate 40 (col. 4, lines 35+). As shown in figures 2 and 7, each card is comprised of a base layer 50, an IC chip 54, and a covering substrate 40 (col. 3, lines 31+). Once the steps mounting chips and  
5 covering resin is hardened, the multi-substrate 60 is cut into multiple memory cards (col. 5, lines 56+).

### ***Response to Remarks***

5. Applicant's remarks filed on July 21, 2004 is carefully considered. Examiner notes that  
10 Applicant submitted a translation of certified copy Japanese Application. Foreign priority papers need not to be translated to claim a foreign priority. However, in view of the Oath claiming foreign priority, previous rejection made relying on the Wada patent (US b,602,734 B1) is withdrawn.

### ***Conclusion***

15 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Haghiri-Teharani discloses an IC card comprising a plurality of mini-cards. Applicant is respectfully suggested to carefully review these references.

20 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the  
25 Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

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*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
September 24, 2004